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EXAMINER	
HONG, STEPHEN S	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/483,175	Applicant(s) XIA ET AL.	
	Examiner Stephen S. Hong	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 9/22/03 .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 1-33 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) 1-33 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Part III DETAILED ACTION

1. This action is responsive to communications: amendment filed on September 22, 2003 to the application, filed on January 13, 2000

2. In the amendment claims 26-33 have been added. Accordingly, claims 1-33 are pending in the case. Claims 1, 21, 23 and 24 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-9, 13-17, 21 and 23-25 remain rejected under 35 U.S.C. 102(e) as being anticipated by GEVER et al., U.S. Pat. No. 6,313,835 B1.

Per independent claim 1; GEVER et al., discloses a method of providing an electronic marketing presentation, comprising:

displaying a marketing object container ("select template-Figure 9;), said marketing object container including a marketing location for receiving at least one marketing object to be presented in said marketing container to a user of an interactive medium ("...Internet banner prepared by double-click for inclusion in a web page selects different advertisements..."-column 1, lines 52-61);

associating a marketing attribute with the marketing object container ("user assigns conditional values or attributes of the animation sequence"-column 2, lines 26-35; see element **40**-Figure 3, element **120**-Figure 5; "user is able to change at least some of the attributes of the selected animation sequence, such as *colors, borders, sounds, embedded pictures...*"-column 2, lines 10-20); and

selecting at least one marketing object for being associated with the marketing object container ("create web page component based on animation sequence..."-column 2, lines 27-31; "prepare interesting Web sites and Web advertisements in order to attract customers and maintain their standing..."-column 1, lines 21-24; *e.g.*, animations **56**-FIG. 3).

Per independent claims 23-24; these claims are directed to a system and computer product, respectively, for performing the method of independent claim 1, supra, and thus are identically rejected.

Per dependent claim 2, GEVER et al. further discloses: displaying a marketing object container icon (*e.g.*, compose condition button **128**-FIG. 5), wherein an *option*

associated with the marketing object container is presented when the icon is selected (*e.g.*, Preferably, interface **100** includes a command section **120** for adding *conditional branch commands*...and id preferably altered using a conditional editor interface, which is invoked by a condition control **128**"-column 13, line 63 to column 14, line 6) .

Per dependent claim 3; GEVER et al. further discloses: presenting a plurality of attributes to associate with the marketing object container ("user is able to change at least some of the attributes of the selected animation sequence, such as colors, texts, fonts, characters, borders, sounds, embedded pictures and models"-column 2, lines 15-20).

Per dependent claim 4; GEVER et al. further discloses: presenting a plurality of marketing objects that are compatible with the selected attribute ("Picture control **50** is similarly used to enter pictures into the animation sequence. Preferably, the user may import pictures which are represented in substantially any standard format. The picture is passed to server **26**, where it is converted if necessary into a standard format suitable for use in the animation sequence, and the description in the standard format is stored in the location allocated for the created Web page component"-column 9, lines 43-50 *et seq*, See example, element 40-Figure 3).

Per dependent claim 5; GEVER et al. further discloses: associating a style template with the marketing object container ("select template"-FIG. 9).

Per dependent claim 6; GEVER et al. further discloses: further comprising filling in an object into the style template (*e.g.*, "Preferably, the user may import pictures which

are represented in substantially any standard format. The picture is passed to server **26**, where it is converted if necessary into a standard format suitable for use in the animation sequence, and the description in the standard format is stored in the location allocated for the created Web page component"-column 9, lines 43-50 *et seq*. See also via example, element **40**-Figure 3; "placeholders"-column 6, lines 50-60; "... the user preferably changes the attributes by selecting from a predefined group of replacements available from server **26**. For example, in order to change character **60**, seen in the animation, the user selects the character, ... a pop-up window **54** displays a plurality of characters from which the user may select a replacement for character **60**"-column 9, lines 5-15).

Per dependent claim 7; GEVER et al. further discloses: comprising associating an item with the marketing attribute ("Preferably, the user may import pictures which are represented in substantially any standard format. The picture is passed to server **26**, where it is converted if necessary into a standard format suitable for use in the animation sequence, and the description in the standard format is stored in the location allocated for the created Web page component"-column 9, lines 43-50 *et seq*. See also example, element **40**-Figure 3. See also citation for claim 14, supra, *i.e.*, column 9, lines 5-15).

Per dependent claim 8; GEVER et al. further discloses: selecting a style for the marketing object container ("select template"-FIG. 9; "...selects from a plurality of basic animation sequences... or able to change at least some of the attributes of the selected

animation sequence, such as the *colors, text, fonts, characters, borders*, sounds, embedded pictures, and models"-column 2, lines 15-30).

Per dependent claim 9; GEVER et al. further discloses: associating a feature with the marketing object container ("attributes"-abstract).

Per dependent claim 13; GEVER et al. further discloses associating the at least one marketing object with the feature ("Preferably, the user may import pictures which are represented in substantially any standard format. The picture is passed to server **26**, where it is converted if necessary into a standard format suitable for use in the animation sequence, and the description in the standard format is stored in the location allocated for the created Web page component"-column 9, lines 43-50 *et seq*. See also example, element **40**-Figure 3).

Per dependent claim 14; GEVER et al. further discloses: wherein the marketing object container is dynamically associated with the marketing attribute ("conditional branch"-FIG. 5; "dynamic web page component which reacts differently, *i.e.* which presents a different display to visitors, ... according to a predetermined scheme"-column 2, lines 30-40).

Per dependent claim 15; GEVER et al. further discloses: wherein the marketing object container is dynamically associated with the marketing object ("preferably, the user selects a plurality of web page components and for each web page component states a

condition that must be fulfilled in order for the particular component to be displayed"-column 2, lines 40-45).

Per dependent claim 16; GEVER et al. further discloses wherein a plurality of marketing objects are selected to be associated with the marketing object container, and wherein the marketing attribute determines which of the selected marketing objects is associated with the marketing object container at a particular time ("dynamic web component, which is displayed differently to visitors at different times"-column 2, lines 60-65).

Per dependent claim 17; GEVER et al. further discloses: wherein the selected marketing objects are associated with the marketing object container according to a schedule ("receiving a scheme which depends on the time at which the dynamic component is displayed"-column 5, lines 10-15).

Per independent claim 21; GEVER et al. discloses a method of creating a marketing presentation comprising:

defining the location and size of a marketing object container in the display medium (*inherent* in the template "select template" (*step not labeled*)-FIG. 9) ;

associating a marketing attribute with the marketing container, the marketing attribute including parameters that define haw the marketing object container can be used in a marketing presentation container ("user assigns conditional values or attributes of the animation sequence"-column 2, lines 26-35; see element **40**-Figure 3, element **120**-Figure

5; "user is able to change at least some of the attributes of the selected animation sequence, such as *colors, borders, sounds, embedded pictures...*"-column 2, lines 10-20); receiving subsequently from a user a selection of the marketing object container and at least one marketing object to be displayed in the marketing object container ("create web page component based on animation sequence..."-column 2, lines 27-31; "prepare interesting Web sites and Web advertisements in order to attract customers and maintain their standing..."-column 1, lines 21-24; *e.g.*, animations **56**-FIG. 3; *e.g.*, "Place Picture here"-FIG. 3, "placeholders"-column 6, lines 50-60; "... the user preferably changes the attributes by selecting from a predefined group of replacements available from server **26**. Fore example, in order to change character **60**, seen in the animation, the user selects the character, ... a pop-up window **54** displays a plurality of characters from which the user may select a replacement for character **60**"-column 9, lines 5-15);

binding the at least one marketing object to the marketing object container ("posting the web page component including the animation sequence with the changed attributes to a web page"-column 4, lines 15-16; *i.e.*, GEVER et al. COULD NOT have functioned as described if the changes were not bound, therefore it MUST have taught binding); and

displaying the marketing object in the marketing object container in accordance with the parameters of the marketing attribute (...evaluated when the Web page component is viewed. Preferably, changing one or more attributes includes adding conditional flow directives to the animation sequence..."-column 4, lines 30-32).

Per dependent claim 25, GEVER et al. *inherently* discloses: a data signal embodied in a carrier wave and a system memory, because it COULD NOT have functioned as described otherwise. It further implies a CD-ROM, floppy disk, tape, flash memory, and hard drive. It is noted that dependent claim 25 recites a *Markush* group. - *See Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). It is noted, nonetheless, that CD-ROM, floppy disk, take, flash, system memory and data signal embodied in a carrier wave were all recognized as interchangeable means of transporting and storing a computer program, and thus were implicitly disclosed in the computer program of GEVER et al..

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 12 and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over GEVER et al.

Per dependent claim 12, GEVER et al. demonstrates all elements as applied in the rejection of dependent claim 9, supra. "Official Notice" is hereby taken that it was notoriously well-known to associate product literature with an advertisement. It would have been obvious to *PHOSITA* at the time of the invention to associate product literature in GEVER et al. by providing an authoring tool to hyperlink to literature about GEVER et al., and in order to provide the user of GEVER et al. with further information about a product in its advertisement, in order to assist the user in making a purchasing decision.

Per dependent claim 19, GEVER et al., implies wherein the at least one marketing object is displayed after it has been approved, because the user of GEVER et al. customizes the authoring object, and it is *implied* the he/ she approved it before displaying it on his/ her web page. Thus this feature is obvious over to a **P**erson **H**aving **O**rdinary **S**kill **I**n **T**he **A**rt, *i.e.*, *PHOSITA*, at the time of the invention over GEVER et al., alone, because it was *implied* by the GEVER et al. reference that at least the author approved of the object because it would not make sense for him/ her to insert an object that was unapproved. "In considering the disclosure of a reference, it is proper to take into account... the inferences which one skilled in the art would be reasonably expected to draw therefrom"-*In re Prada*, 401 F.2d 825, 159 USPQ 342, 344 (CCPA1968) cited in MPEP 2144.01.

7. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over GEVER et al., US 6,313,835 B1, in view of TOBIN, US Patent no. 6,141,666 A, issued 10/2000.

Per dependent claim 18, GEVER et al. demonstrates all elements as applied in the rejection of dependent claim 17, supra. GEVER et al. further *implies*: wherein the selected marketing objects are inserted in the marketing object container based on a second marketing object of a second marketing object container ("... select a link address **64** in the display window, and using 'links' control **55**, along with a respective entry window, any change the address of the link"-column 9, lines 37-42).

TOBIN, on the other hand, explicitly demonstrates customizing a web site based on a referring partner (...data which is dynamically retrieved by the database means in response to the particular class in which the client belongs, *i.e.*, based on the identity of the network site referring the client to the system server"-column 3, lines 25-30). It would have been obvious to *PHOSITA* at the time of the invention to employ the customization of TOBIN in the advertisement authoring system of GEVER et al., by dynamically customizing the business object of GEVER et al. based on a referring partner *implied* in the ad generation system of GEVER et al., in order to increase the relevance of the business object to the user of GEVER et al.

Per dependent claim 20, GEVER et al. demonstrates all elements as applied in the rejection of independent claim 1, supra. GEVER et al. further *implies*: wherein the

selected marketing objects are inserted in the marketing object container based on a second marketing object of a second marketing object container ("... select a link address **64** in the display window, and using 'links' control **55**, along with a respective entry window, any change the address of the link"-column 9, lines 37-42).

TOBIN, on the other hand, explicitly demonstrates customizing a web site based on a referring partner (...data which is dynamically retrieved by the database means in response to the particular class in which the client belongs, *i.e.*, based on the identity of the network site referring the client to the system server"-column 3, lines 25-30). It would have been obvious to *PHOSITA* at the time of the invention to employ the customization of Tobin in the advertisement authoring system of GEVER et al., by dynamically customizing the business object of GEVER et al., based on a referring partner implied in the ad generation system of GEVER et al., in order to increase the relevance of the business object to the user of GEVER et al.

8. Claims 10-11 and 20 remain and claims 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over GEVER et al., US Patent no. 6,313,835 B1; issued 11/2001, in view of HENSON, US 6,167,383 **B1**.

Per dependent claims 10-11; GEVER et al. lacks an *explicit* recitation of associating a "cross-sell" and "up-sell" feature with its marketing objects. HENSON. on the other hand, demonstrates dynamically associating a banner object **100** (abstract,

col. 9, lines 40-55) wherein an "up-sell" or "cross-sell" feature was associated with the object (col. 9, lines 43-44). It would have been obvious to *PHOSITA* at the time of the invention to combine HENSON with GEVER et al. by providing a "cross-sell" or "up-sell" feature with at least one of the marketing containers of GEVER et al. in order to bind cross-sell and up-sell objects into the template of GEVER et al., for example, in a manner disclosed by HENSON. Furthermore, this would have provided the benefit of increasing likelihood of selling more merchandise in the catalogue system of GEVER et al. in a manner disclosed by HENSON, because it would have been recognized that people would have been more likely to purchase/ consider for purchase related items, and thus the combination would have had the advantage of increasing likelihood of sales of its advertised items.

As per dependent claims 26-33, Gever in view of Henson discloses/suggests the claimed marketing campaign including as explained with respect to claims 10-11, which rationale being incorporated herein. However, Gever does not explicitly disclose that the marketing attribute is configured to describe a relationship of the first marketing object container with a second marketing object container. First, it should be note that the phrase "the marketing attribute is configured to describe a relationship" is a broad term, since the extent of this "relationship" is not clearly defined. Therefore, the relationship can be that there are more than one marking contents that are "related." Therefore, it would have been obvious to a person of ordinary skill in the art at the

time the invention was made to have to include multiple marketing containers, since a person of ordinary skill would have appreciated the effectiveness of the multiple related marketing contents.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over PECKOVER, US 6,119,101 A, issued 09/2000; in view of GEVER et al., US Patent no. 6,313,835 B1; issued 11/2001.

Per independent claim 22; PECKOVER discloses: a method of creating a marketing presentation in an interactive medium, comprising:

displaying a marketing object container on a display medium (*e.g.* step **578**-format, display Template & instructions, *FIG. 31A*);

displaying a number of campaigns that are available to associate with the marketing object container (Use selects *market* **564**-FIG. 31A; *Note the* "market" *described by PECKOVER meets the "broadest reasonable interpretation of campaign, even though identical terminology was not employed.*), each of said campaigns being associated with a plurality of offers compatible with the campaign;

receiving a selection of a campaign to apply to the marketing object container (User selects market, step **564**-FIG. 31A);

displaying a plurality of offers that are compatible with the selected campaign (user selects product or generic Template and instructions, step **576**-FIG. 31A); and

receiving a selection of at least one offer for placing in the marketing object container ("Ad composer" **578**-FIG. 31A, *Note*: an *offer* is inherent in an ad).

PECKOVER lacks an explicit recitation of claimed "in response to selection of a marketing object container"; however, it explicitly discloses templates. GEVER et al. on the other hand, explicitly demonstrates that it was known to select a container and provide a GUI for components to select components to be included in the container (*e.g.*, "Place Picture here"-FIG. 3, "placeholders"-column 6, lines 50-60; "... the user preferably changes the attributes by selecting from a predefined group of replacements available from server **26**. For example, in order to change character **60**, seen in the animation, the user selects the character, ... a pop-up window **54** displays a plurality of characters from which the user may select a replacement for character **60**"-column 9, lines 5-15). It would have been obvious to *PHOSITA* at the time of the invention to employ a GUI for selection of the ad of PECKOVER by presenting a placeholder and selecting the market and offer of PECKOVER in order to have an easy to use GUI for the replacement of elements, e.g., ads, in the template of PECKOVER.

Response to Arguments

10. Applicant's arguments filed on September 22, 2003 have been fully considered but they are not persuasive.

On page 8 of the amendment, Applicant asserts that Gever does not disclose at least two limitations: "marketing attribute" and "associating this marketing attribute with the marketing object." Applicant then explains on page 9, that the Applicant's example of the "marketing attributes include: marketing campaigns and features in merchandising marketing, scheduling of objects to be displayed, behavior-driven targeting of marketing material to a user,... [and the] functions of the claimed marketing attributes.. include describing what marketing objects can be received by the marketing object container, describing the relationship of a particular marketing object container to other marketing object containers, and/or describing timing and priority of the display of marketing objects..." However, Examiner has pointed out that Gever teaches "attributes of the selected animation sequences." In response, Applicant alleges that this is "neither the form of function of the claimed marketing attributes." Examiner disagrees, the animation sequence editing is a form of describing timing and priority of the display of marketing objects, as long as the content of the animation is related to a marketing concept.

On page 10 of the amendment, Applicant argues that the cited text of Gever which states "the user assigns conditional values to the attributes of the animation sequences" is not equivalent to the claimed "associating a marketing attribute with the first marketing object container." Examiner disagrees. When the conditional values of

the attributes are assigned, the attribute values are altered and the altered values are associated with the animation sequences. Thus, the limitation is clearly met.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

After-final (703) 746-7238
Official (703) 746-7239
Non-Official/Draft (703) 746-7240

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Stephen Hong

Primary Examiner

January 11, 2003